

REMARKS

I. Status of Claims

Claims 1-3, 5-13, 18, 19, 21, 24, 28, 32, 34, 35, and 40 are currently pending, with claims 1-3, 5-11, 13, 18, 21, 24, 28, 32, and 34 under examination and claims 12, 19, 35, and 40 withdrawn from consideration. Without prejudice or disclaimer, claims 1 and 32 are amended herein and claim 33 is cancelled. Exemplary support for the amendments can be found in the specification and claims as-filed.

II. Rejection of Claims under 35 U.S.C. § 112, First Paragraph

The Examiner rejects claims 1-3, 5-11, 13, 18, 21, 24, 28, and 32-34 under 35 U.S.C. § 112, first paragraph, as allegedly "failing to comply with the written description requirement." Final Office Action at 2. Specifically, the Examiner makes a new matter rejection and asserts that "[t]here is no support in the specification for 'fusion peak.'" *Id.* Applicant disagrees, and submits that one of ordinary skill in the art would appreciate that the term "fusion" may be used as a synonym for melting. However, in order to advance prosecution, independent claim 1 is amended to replace the phrase "fusion peak" with "melting peak." Accordingly, this rejection is now moot, and Applicant requests withdrawal of the rejection of claims 1-3, 5-11, 13, 18, 21, 24, 28, and 32-34.

III. Rejection of Claims under 35 U.S.C. § 102(b)

The Examiner rejects claims 1-3, 5-11, 13, 18, 21, 28, and 31-34 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,911,105 ("the '105 patent"). This rejection is rendered moot with respect to claim 31, which was previously

cancelled without prejudice or disclaimer of its subject matter, and with respect to claim 33, which is cancelled as of this response. Applicant respectfully traverses the § 102(b) rejection.

In order to properly anticipate Applicant's claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, "either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131.

The Examiner alleges that the disclosure of polystearyl methacrylate in col. 3, lines 65-66, of the '105 patent is actually a disclosure of polystearyl acrylate, which Applicant has elected, and that "the components claimed are [the] same as ... that disclosed." Final Office Action at 3. Without acceding to these allegations, Applicant submits that the '105 patent does not disclose each and every element of Applicant's claimed invention as recited in amended independent claim 1. This is at least because the '105 patent does not disclose

[a] cosmetic composition comprising, in a physiologically acceptable medium, at least one compound which gives the cosmetic composition a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C, the at least one compound having a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C ... **wherein the cosmetic composition is heat-stable**

as recited in amended independent claim 1 (emphasis added).

Applicant submits that the compositions disclosed by the '105 patent are not heat-stable as required by claim 1. By way of demonstration, Applicant prepared two compositions consistent with Example 29 of the '105 patent, and submits the resultant data in a Declaration under 37 C.F.R. § 1.132 ("the Declaration"). Initially, Applicant points out that no example of the '105 patent discloses the use of Applicant's elected homopolymer, polystearyl acrylate. Some examples of the '105 patent disclose the use of polystearyl methacrylate, and Applicant considered those examples. *See* Declaration at page 2, paragraph 6. Because Example 29 of the '105 patent is directed to a mascara that may use polystearyl methacrylate, Applicant prepared two compositions (Compositions A and B) based on Example 29 of the '105 patent. *See id.*

Composition A was prepared with polyvinyl laurate because polyvinyl stearate, the homopolymer used in Examples 1 and 29 of the '105 patent, was not available at the time. Composition B was prepared with a polystearyl acrylate - dimethicone methacrylate copolymer. All other components in Compositions A and B matched those present in the composition of Example 29, including their proportions. *See id.*, page 3, paragraph 8, through page 4, paragraph 9.

As shown in the attached Declaration, the heat stability of Compositions A and B were assessed using the method described in Applicant's specification at page 3, lines 7-15. Neither Composition A nor Composition B possessed the heat-stability required by independent claim 1. *See* Declaration at paragraph 11. In view of the results

described in the Declaration, Applicant submits that cosmetic compositions disclosed by the '105 patent do not inherently possess the heat stability required by independent claim 1. See Declaration at paragraph 12.

Thus, the '105 patent does not disclose that "the cosmetic composition is heat-stable," as recited in independent claim 1, and for at least this reason, the '105 patent does not anticipate amended independent claim 1. Amended independent claim 32, while differing in scope from claim 1, recites the similar limitation that "the cosmetic composition is heat-stable." Amended independent claim 32 is therefore not anticipated by the '105 patent for reasons similar to those presented above in regard to claim 1. Claims 2, 3, 5-11, 13, 18, 21, 28, 31, and 34 are also not anticipated, at least due to their dependence from claim 1 or 32. Applicant therefore requests withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1-3, 5-11, 13, 18, 21, 28, 31, 32, and 34.

IV. Rejection of Claims under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-3, 5-14, 18, 21, 24, 28, 31-34 under 35 U.S.C. § 103(a) as being unpatentable over the combination of the '105 patent and U.S. Patent No. 6,875,245 ("the '245 patent"). This rejection is rendered moot with respect to claims 14 and 31, which were previously cancelled without prejudice or disclaimer of their subject matter, and with respect to claim 33, which is cancelled as of this response. Applicant respectfully traverses the § 103(a) rejection.

Determining the obviousness of a claimed invention under 35 U.S.C. § 103 requires that the Office apply three factual inquiries, which were originally outlined in

Graham v. John Deere Co., and reaffirmed in *KSR International Co. v. Teleflex, Inc.*
See *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007) ("...the [*Graham*] factors continue to define the inquiry that controls."). Accordingly, in order to establish a *prima facie* case of obviousness, the Office must objectively perform each of the following factual inquiries:

- (A) Ascertain the scope and contents of the prior art;
- (B) Ascertain the differences between the claimed invention and the prior art; and
- (C) Resolve the level of ordinary skill in the pertinent art.

See *Graham* 383 U.S. 1 at 17-18; see also M.P.E.P. § 2141. The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; see also *KSR*, 127 S. Ct. at 1734, 82 U.S.P.Q.2d at 1391.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. §2143.01(III), internal

citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

The Examiner has not established a *prima facie* case of obviousness. Applicants established above that the '105 patent does not anticipate amended independent claim 1. The '105 patent also does not suggest the subject matter of amended independent claim 1. This is at least because the '105 patent does not suggest

[a] cosmetic composition comprising, in a physiologically acceptable medium, at least one compound which gives the cosmetic composition a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C, the at least one compound having a thermal profile having a melting peak wherein the mid-height width Lf is less than or equal to 20°C ... **wherein the cosmetic composition is heat-stable**

as recited in amended independent claim 1 (emphasis added).

First, the '105 patent does not disclose or suggest that the compositions it discloses are heat-stable or that heat-stability is an objective of the '105 patent. Second, as discussed above, Applicant has demonstrated that compositions disclosed by the '105 patent are not inherently heat stable.

In addition, one of ordinary skill in the art would not have considered it obvious to modify the '105 patent in an attempt to achieve a composition that was heat-stable, and certainly not in an attempt to achieve Applicant's claimed invention. As established

above, the '105 patent does not disclose or suggest that any composition it discloses is heat stable. Moreover, as shown in the Declaration, given that Applicant's Composition A (based on Example 29 and including a homopolymer) and Composition B (based on Example 29 and including a copolymer) **both** were not heat stable, it is apparent that the '105 patent does not render obvious heat stability. For at least these reasons, the '105 patent does not suggest Applicant's claimed invention as recited in amended independent claim 1.

The '245 patent does not overcome the deficiencies of the '105 patent. The Examiner relies on the '245 patent for its alleged disclosure of "mascara compositions using gum arabic." Final Office Action at 7. Without acceding to this allegation, Applicant submits that the '245 patent does not disclose or suggest a cosmetic composition that is heat-stable, as required by independent claim 1. For at least this reason, the '105 patent, even if combined with the '245 patent, does not disclose or suggest Applicants' claimed invention as recited in amended independent claim 1. Amended independent claim 32, while differing in scope from claim 1, recites the similar limitation that "the cosmetic composition is heat-stable." Therefore, the '105 patent and the '245 patent, even if combined, do not disclose or suggest Applicants' claimed invention as recited in independent claim 32.

In the Final Office Action, the Examiner asserts that "[a]ll the components claimed in the instant application are also claimed in the patent therefore the composition claimed in the patent would also have the same thermal profile. Note that

PTO is not equipped to determine the thermal profile by heating an empty crucible and a crucible containing a sample of the claimed composition.” Final Office Action at 5. Applicant respectfully disagrees. Without acceding to the Examiner’s assertion regarding the components claimed in the instant application, Applicant submits that the claimed heat stability (which the Examiner refers to as thermal profile in the excerpt from the Final Office Action, quoted above) is **not a resulting property** of the Examiner’s proposed combination of the ‘105 and ‘245 patents.

M.P.E.P. § 2112 states that inherency may have relevance to obviousness. However, the fountainhead case relied on in the M.P.E.P. is In re Grasselli, 713 F.2d 731,737 (Fed. Cir. 1983), which is relied on in In re Napier, 55 F.3d 610 (Fed. Cir. 1995), also cited in M.P.E.P. § 2112. As seen at page 776 of Grasselli, in rejecting an obviousness argument based on inherency, the court stated:

“If appellant’s catalyst is inherent in the Japanese Patent, it has not been established by the record here and obviousness cannot be predicated on that which is unknown.”

As established above, neither the ‘105 patent nor the ‘245 patent discloses that “the cosmetic composition is heat-stable,” as required by claim 1. The heat stability required by claim 1 is therefore not a resulting property of a combination of the ‘105 and ‘245 patents, but rather is necessarily unknown.

And as recognized in the M.P.E.P., Grasselli holds that obviousness cannot be predicated on that which is unknown. Therefore, the rejection under 35 U.S.C. § 103(a) should be withdrawn for that additional reason.

The Examiner's proposed combination of the '105 and '245 patents, therefore, does not render obvious the present claims. Amended independent claims 1 and 32 should be allowable over the '105 and '245 patents. Claims 2, 3, 5-14, 18, 21, 24, 28, 31, and 34 should also be allowable, at least due to their dependence from claim 1 or 32. Applicant requests withdrawal of the rejection of claims 1-3, 5-14, 18, 21, 24, 28, 31, 32, and 34.

V. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: April 9, 2009

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Attachments: Declaration under 37 C.F.R. § 1.132 of Nathalie Jager Lezer.

In re Napier, 34 USPQ2d 1782 (Fed. Cir. 1995)

In re Grasselli, 218 USPQ 769 (Fed. Cir. 1983).